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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Scott Clare et al

Docket No.: SC/C-I-P-4C

Serial No.: 09/083,422

Art Unit: 3615

Filed: May 22, 1998

Examiner: A. Pike

For: Hidden Storage for Vehicles

PETITION TO THE COMMISSIONER
UNDER 37 CFR 1.181

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicants hereby petition the Commissioner of Patents and Trademarks under 37 CFR 1.181 to review requirements and statements made by the Examiner in the Office Actions mailed August 18, 1998 and October 9, 1998 in the above-identified application. Similar requirements have been made by the same Examiner in Application Serial No. 08/896,392 and in Application Serial No. 08/910,516. It is requested that the following requirements or statements made by the Examiner be reviewed in that such are deemed to be inconsistent with the MPEP, Guide for the Preparation of Patent Drawings, and current practice within the Office, or constitute an incorrect

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interpretation by the Examiner of the rules of practice.

1. Must a declaration in each application specifically identify each parent, grandparent, great grandparent, etc., when the parent application has been identified in the declaration of its parent application and the grandparent application has also been identified in its declaration? In the instant application, the parent is one of a chain of C-I-P applications and is specifically identified in the declaration, but the Examiner contends that each application in that chain must be specifically identified in the declaration of the instant application. The instant application is a continuation (not a C-I-P) of Application S.N. 08/910,516 filed August 1, 1997, now issued, and carries the declaration of its parent application.

2. Must the identical component, when illustrated in two or more figures, be given a different reference numeral in each figure? The MPEP 608.02 (p) (4) states:

"The same part of an invention appearing in more than one view of the drawing must always be designated by the same reference character, and the same reference character must never be used to designate different parts." (underlining added)

In the instant application, Figures 9-12 illustrate modification of the same storage box 103 having a wheel well 104, and the Examiner has required that numerals 103 and 104 in Figures 10-12 each be renumbered differently, which is clearly contrary to the above-

quoted statement from MPEP 608.02. Similar objections have been made to Figures 15-16. The Examiner's position is also inconsistent with the "Guide for the Preparation of Patent Drawings", copy enclosed.

3. Must each figure be separately identified by a separate paragraph in the Brief Description of the Drawings section of the application? The Examiner contends that no two figures can be described in the same paragraph in that section of the application. In the instant application, see page 6, the brief description of Figures 1-4, 8A-8B, 9-12, 13-14 and 15-16 are objected to because more than one figure is described in the same paragraph.

4. Is the use of Figure 8A and Figure 8B improper? The Examiner contends that each figure "must be numbered in consecutive Arabic numerals", and thus Figure 8A and Figure 8B are not "consecutive Arabic numerals" and must be changed. This position is clearly inconsistent with current Office practice wherein the use, for example, of Figure 1A, Figure 1B, Figure 1C, etc. finds wide use. Further, the above-referenced "Guide for the Preparation of Patent Drawings" published by the Patent and Trademark Office illustrates the use of Figures 7A-7C and Figures 8A-8C, as being "Proper" (see page A-4-23). The Examiner has been previously provided with a copy of this "Guide" but has apparently ignored it since the same objections were repeated in the 10/9/98 Office Action, and no reference was made thereto in that Office Action.

5. Is it proper for the Examiner to refuse entry of proposed drawing corrections merely because all of the Examiner's

objections were not overcome? In the instant application, proposed drawing corrections were submitted to make all changes to overcome the objections except those deemed to be improper. The Examiner has disapproved those proposed changes and repeated the objections which would have been removed by the proposed changes. Such action on the part of the Examiner is deemed improper, and only serves to impose a greater burden on Applicants to resubmit the same changes.

6. Is it proper for the Examiner to require submittal of "formal drawings" when no claim has been allowed? On page 17 of the 10/9/98 Office Action, the Examiner states:

"Applicants failed to submit formal drawings as required."

Had Applicants submitted "formal drawings", such would have been disapproved because each and every objection raised by the Examiner would not have been included.

7. It is proper for the Examiner to require submittal of formal drawings because the instant application "is a continuation of allowed application Serial No. 08/910,516"? See page 28 of the 10/9/98 Office Action. No claim in the instant application has been allowed, and it is deemed improper for the Examiner to require submittal of formal drawings merely because a parent application has been allowed.

8. On pages 17-19 of the 10/9/98 Office Action, the Examiner sets forth various objections to the drawings, and requires

corrections, part of which Applicants have previously submitted and which were denied entry by the Examiner. These objections include:

A. Renumbering of the same components appearing in more than one figure, such as components 103 and 104 of Figures 9-12, components 120, 121, 122, 126-129, etc. of Figures 13-14, and components 150-156 of Figures 15-16.

B. Renumbering of Figures 8A and 8B because they are not "consecutive Arabic numerals". As set forth, for example, on page 6 of Applicants' specification, "Figures 8A and 8B are rear views of vehicles", the only different being in the configuration of the rear of the vehicle. According to the above reference "Guide", the use of 1A, 1B, 1C, etc. appears to constitute the require consecutive numerals.

C. The drawings are objected to because the "bulkhead section" (Claim 28, line 2) is not shown. As pointed out previously, the "bulkhead" of the bed of Figure 2 is shown with the reference number "12" thereon. Also, the "bulkhead section" is shown directly behind the cab in Figure 4. All pickup beds have bulkheads. However, the Examiner has repeated this objection.

D. Page 19 of the 10/9/98 Office Action states:

"New Formal Drawings are required in response to this Office Action."

Where no claims have been allowed, and where the proper numbering of the figures and the numbering of the same component in different figures is in dispute, to require Applicants to submit "New Formal

Drawings" at this time is deemed to be improper and only serves to impose an unnecessary burden on Applicants. Is such a requirement proper?

It is submitted that the Examiner, as set forth in the Office Actions mailed August 18, 1998 and October 9, 1998, imposes an improper and unnecessary burden on Applicants' to submit a new Declaration and to amend the specification and drawings to comply with each and every objection raised by the Examiner, particularly where the objections appear to be inconsistent with the MPEP, the Guide for the Preparation of Patent Drawings published by the Patent and Trademark Office, and the current practice within the Office.

This Petition to the Commissioner is requesting review of each of these above items since these same, or very similar, objections are also being raised by the same Examiner in Applicants' copending application 08/896,392, and these objections will undoubtedly be raised in pending Application S.N. 09/082,281, filed May 20, 1998, which will most likely be examined by this same Examiner.

Dated: 11-2-98

Respectfully Submitted,



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Enclosure:
Sections of "Guide for the
Preparation of Patent Drawings"

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TRADEMARK OFFICE

Guide for the Preparation of Patent Drawings

U.S. DEPARTMENT OF COMMERCE

Ronald H. Brown
Secretary



PATENT AND TRADEMARK OFFICE

Bruce A. Lehman
Assistant Secretary of Commerce and
Commissioner of Patents and Trademarks

October 1993

forth in § 1.71(e) is included at the beginning (preferably as the first paragraph) of the specification.

Examples are provided in Appendix 4.

(t) Numbering of sheets of drawings. The sheets of drawings should be numbered in consecutive Arabic numerals, starting with 1, within the sight as defined in paragraph (g) of this section. These numbers, if present, must be placed in the middle of the top of the sheet, but not in the margin. The numbers can be placed on the right-hand side if the drawing extends too close to the middle of the top edge of the usable surface. The drawing sheet numbering must be clear and larger than the numbers used as reference characters to avoid confusion. The number of each sheet should be shown by two Arabic numerals placed on either side of an oblique line, with the first being the sheet number, and the second being the total number of sheets of drawings, with no other marking.

For example, the numbering at the top of the sheet would indicate that sheet to be the second sheet of a total of six sheets. If the arrangement of the view is rotated as set forth in section (i), the sheet number must remain as set forth in this section (t).

(u) Numbering of views.

(1) The different views must be numbered in consecutive Arabic numerals, starting with 1, independent of the numbering of the sheets and, if possible, in the order in which they appear on the drawing sheet(s). Partial views intended to form one complete view, on one or several sheets, must be identified by the same number followed by a capital letter. View numbers must be preceded by the abbreviation "FIG." Where only a single view is used in an application to illustrate the claimed invention, it must not be numbered and the abbreviation "FIG." must not appear.

(2) Numbers and letters identifying the views must be simple and clear and must not be used in association with brackets, circles, or inverted commas. The view numbers must be larger than the numbers used for reference characters.

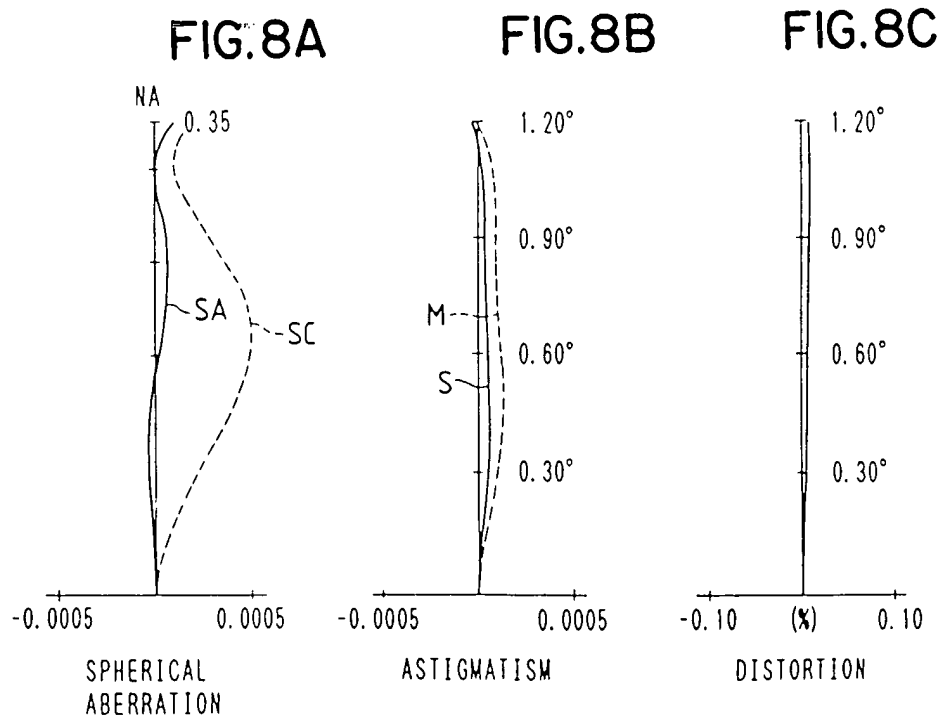
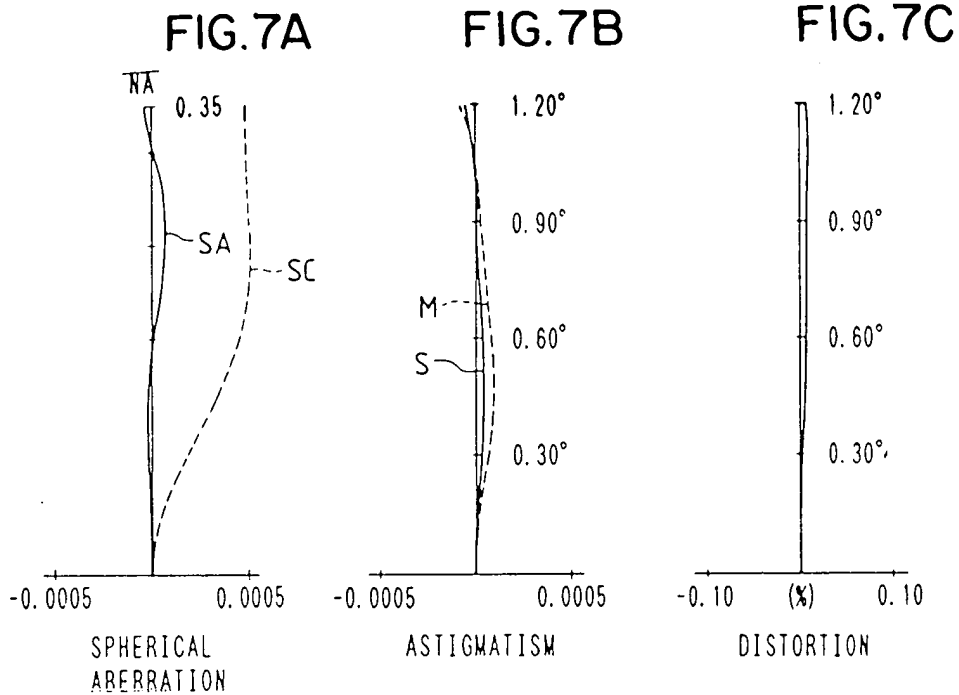
Example 10

Example 10 is a **proper** illustration of a graphical form which is used to represent optical aberrations of lenses which may be submitted as drawings. The drawing meets the requirements of

Paragraph (d) Graphic forms in drawings

The drawing also meets the requirements of

Paragraph (a)(1)	Black ink.
Paragraph (l)	Character of lines, numbers, and letters.
Paragraph (o)	Legends.
Paragraph (p)	Numbers, letters, and reference characters.
Paragraph (q)	Lead lines.
Paragraph (u)	Numbering of views.



**Example 10 - Proper
Paragraph (d). Graphic forms in drawings.**

Example 16

Example 16 is a **proper** illustration of a partial view which includes an enlarged view that may be submitted as a drawing. The drawing meets the requirements of

Paragraph (h)(2) Partial views

Additionally, the drawing meets the requirements of

Paragraph (a)(1)	Black ink.
Paragraph (l)	Character of lines, numbers, and letters.
Paragraph (p)(1)	Numbers, letters, and reference characters.
Paragraph (q)	Lead lines.
Paragraph (r)(1)	Arrows.
Paragraph (u)	Numbering of views.

FIG. 7

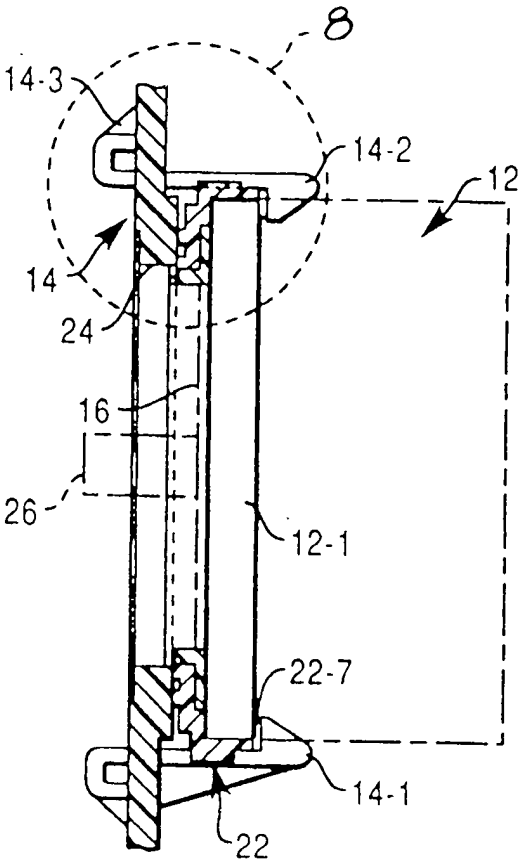
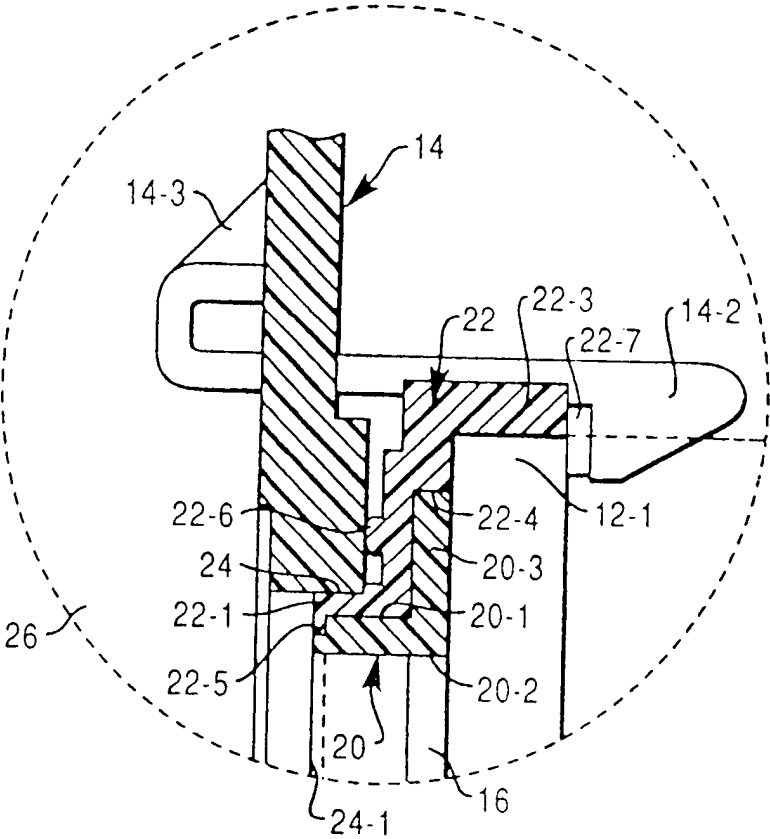


FIG. 8



**Example 16 - Proper
Paragraph (h)(2). Partial views.**

Example 20

Example 20 is provided as an **improper** illustration of a sectional view, although Fig. 1, which is **proper**, is included to show the difference. Note that the view from which the section is taken is not properly hatched in Fig. 2, at reference numeral 1. The drawing does not meet the requirements of

Paragraph (h)(3) Sectional views

However, the illustration does meet the requirements of

Paragraph (a)(1)	Black ink.
Paragraph (h)	Views , wherein views are clearly separated from one another.
Paragraph (i)	Arrangement of views.
Paragraph (l)	Character of lines, numbers, and letters.
Paragraph (p)(1)	Numbers, letters, and reference characters.
Paragraph (q)	Lead lines.
Paragraph (u)	Numbering of views.

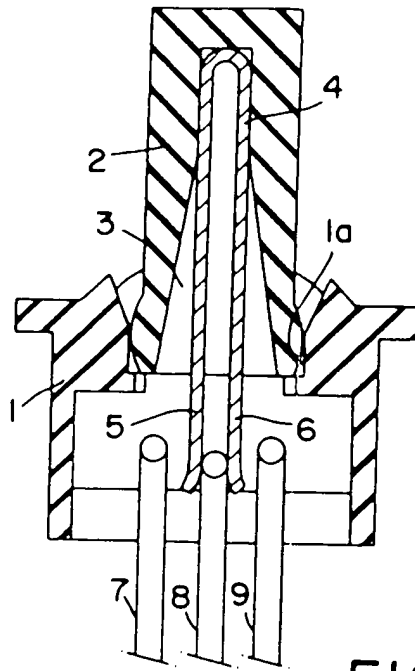


FIG. 1

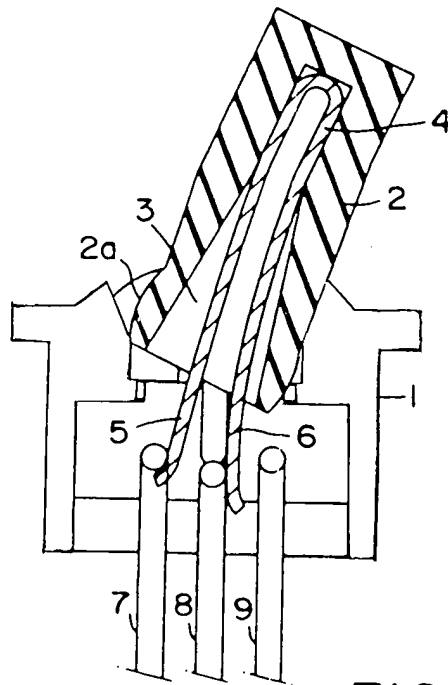


FIG. 2

Example 20 - Improper
Paragraph (h)(3). Sectional views.

Example 24

Example 24 is a **proper** illustration of a drawing which contains modified forms which may be submitted as a drawing. Note that Figs. 2 and 3 show fastening means 52, 53, 62, and 63 in separate figures. If desired, elements 62 and 63 could also be designated as 52' and 53' as modified forms of fastening means. The drawing meets the requirements of

Paragraph (h)(5) Modified forms

Additionally, the drawing meets the requirements of

Paragraph (a)(1)	Black ink.
Paragraph (h)(3)	Sectional views.
Paragraph (i)	Arrangement of views.
Paragraph (l)	Character of lines, numbers, and letters.
Paragraph (m)	Shading.
Paragraph (p)	Numbers, letters, and reference characters.
Paragraph (q)	Lead lines.
Paragraph (u)	Numbering of views.

Another illustration of a modified form is shown at Example 25.

FIG. 2

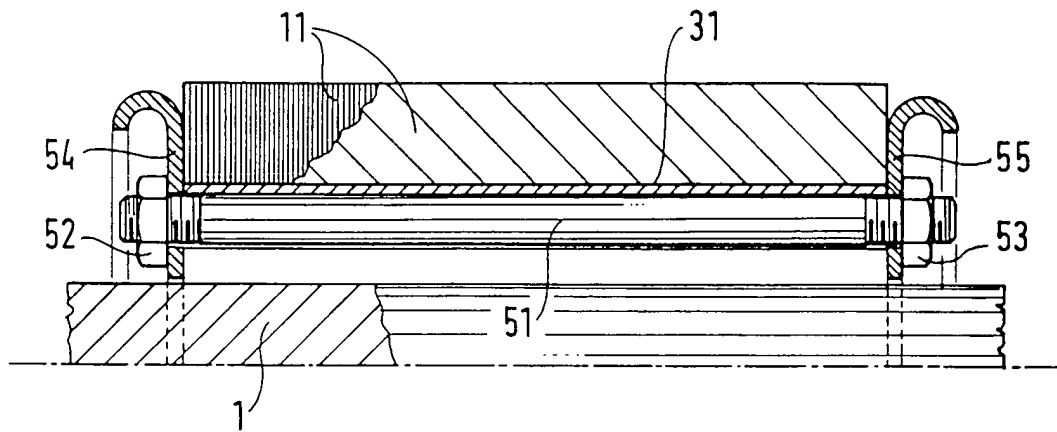
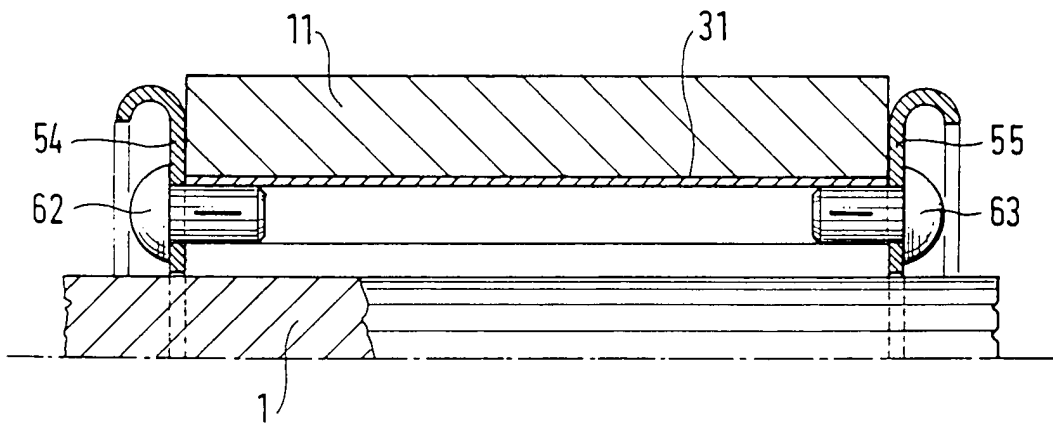


FIG. 3



Example 24 - Proper
Paragraph (h)(5). Modified forms.